

REMARKS/ARGUMENTS

Claims 10-25, 35 and 36 remain in the application.

Claim 21 is currently amended.

Claim Rejections Under 35 U.S.C. § 102

5. **Claims 21 and 35 were rejected under 35 U.S.C. § 102(b) as being unpatentable over US Patent 922,858 to Conley.**

The present invention is clearly patentable over Conley, which teaches a “book clasp” (see, e.g., title) structured for “holding an account book in a closed position, so that bills and other loose papers may be held in the book.” Lines 20-23 (emphasis added). The book clasp has a 10 bar corresponding in “length” to a “width” of a book. See, e.g., claim. A band of elastic material is connected at both ends (see, e.g., Figure) to the ends of the bar and extended around the book. See, e.g., claim and Figure. The elastic band is connected to the bar by rivets. Lines 50-53. The means for attaching the elastic band may be other than rivets “so long as they perform their proper functions.” Lines 62-65.

15. First, the bar portion of the Conley book clasp is not structured for supporting an open book thereon, as recited in claim 35. The book clasp of Conley is only structured for “holding an account book in a closed position.” Lines 20-23 (emphasis added). The “closed position” is necessary “so that bills and other loose papers may be held in the book.” Lines 20-23. Thus, the book clasp is clearly not “inherently” capable of holding the book in an “open” position, as recited 20 in claim 35. Rather, the book clasp of Conley must hold the book in an open position because that would render it unsatisfactory for its intended function of holding bills and other loose papers in the book. See, lines 20-23.

25. Additionally, the bar portion of the book clasp of Conley is not “structured for supporting an open book thereon crosswise to a spine of the open book with two opposite covers of the spine of the book laying adjacent to the elongated support bar,” as recited in claim 35. Rather, the book clasp has a bar corresponding in “length” to a “width” of a book. See, e.g., claim. Thus, the bar cannot support an “open” book crosswise to a spine of the open book with two opposite covers of the spine of the book laying adjacent to the elongated support bar,” as recited in claim 35.

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Furthermore, the elastic band of Conley is not an “elongated resilient elastic retainer structured for gripping and holding the pages of an open book supported on the support bar with the pages substantially compressed against respective opposite covers of the open book and holding the covers of the open book substantially compressed against the support bar,” as recited in claim 35. Rather, the elastic band of Conley is structured for “holding an account book in a closed position.” Lines 20-23. It is necessary to the function of the book clasp of Conley that the elastic band is structured for holding a book in a “closed” position rather than an “open” position “so that bills and other loose papers may be held in the book.” Lines 20-23. Thus, the elastic band of Conley clearly cannot be structured for holding the book in an “open” position, as recited in claim 35. Rather, the book clasp of Conley must hold the book in an open position because that would render it unsatisfactory for its intended function of holding bills and other loose papers in the book. See, lines 20-23.

For at least the above reasons, the invention as recited in claim 35 is not anticipated by the book clasp of Conley and is clearly allowable thereover.

The book clasp of Conley also fails to anticipate the elastic retainer having at least one of the first and second ends being “releasably” anchored to the support bar, as recited in claim 35. Rather, Conley only teaches elastic band being unreleasably connected to the bar. Conley teaches the elastic band being connected to the bar by rivets. Lines 50-53. Obviously, rivets can only connect the elastic band unreleasably to the bar..

Alternatively, Conley teaches the elastic band may be attached by other “means” than rivets. But such other “attaching means” still must unreleasably connect elastic band to the bar because the other “attaching means” still must “perform their proper functions.” Lines 62-65. The only function of the rivets or other attaching means disclosed by Conley is fixedly attaching the elastic band to the bar.

The only disclosed means for removing the elastic band is if it should “break in use.” Lines 59-62. Thus, the only means for removing the band is by destruction, which clearly renders the book clasp device unsatisfactory for its intended function of holding bills and other loose papers in the book. Obviously, it cannot be taught to remove the elastic band by destruction.

Therefore, the rivets or other attaching means must unreleasably connect elastic band to the bar because that is the only function disclosed by Conley.

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Accordingly, Conley clearly does not anticipate the elastic retainer having at least one of the first and second ends being “releasably” anchored to the support bar, as recited in claim 35.

For at least the above additional reasons, the invention as recited in claim 35 is clearly not anticipated by the book clasp of Conley and is clearly allowable thereover. Reconsideration and allowance are respectfully requested.

Claim 21 is allowable at least as depending from allowable claim 35.

Claim 21 is further allowable independently of allowable base claim 35 as reciting the elastic retainer including “releasable anchors on each of its first and second ends.” As discussed above, in contrast to the “releasable” anchors recited in claim 21, the rivets or other attaching means must unreleasably connect elastic band to the bar because that is the only function disclosed by Conley.

For at least the above additional reasons, the invention as recited in claim 21 is clearly not anticipated by the book clasp of Conley and is clearly allowable thereover. Reconsideration and allowance are respectfully requested.

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Claims 36, 10, 11, 14 and 18 were rejected under 35 U.S.C § 102(b) as being unpatentable over US Patent 2,645,197 to Jones.

The present invention is clearly patentable over Jones, which teaches a “book marker” (see, e.g., title) which includes a back member 12 that telescopes to fit the “height” of spines of different books. Lines 39-49. Several “page separating cords” 30 extend from a hook 20 at one end of the back member 12 and attach to a row of notches 36 in a rack 24 at the opposite end. Column 2, lines 20-34. When in use, the back member 12 is aligned with the spine of the book, the upper end at the back of the book is engaged by the hook 20 and the tongue 26 is inserted as far as possible into the [lower end] of the book. Column 2, lines 7-40. The several book page separating cords 30 are “interposed between the book pages.” Column 2, lines 40-43. Thus, the book marker 10 is satisfactory for its intended function of facilitating the convenient and expedition opening of a book at several different passages. Column 1, lines 1-6.

First, the back member 12 of the Jones book marker is not structured for supporting an open book thereon, as recited in claim 36. The book marker of Jones is only structured for marking passages in a book for consultation in a predetermined order. Column 3, lines 2-4. The

back member 12 is only attachable to the book along its spine because the hook 20 is structured to engage the top of the spine, while the tongue 26 is structured to be "inserted" into the bottom of the spine. Column 2, lines 7-40. The "page separating cords" 30 are only structured to be "interposed between the book pages." Column 2, lines 40-43. Thus, the book marker is clearly

5 not "inherently" capable of holding the book in an "open" position, as recited in claim 36. In fact, the book marker is clearly not "inherently" capable of "supporting an open book thereon across to a spine of the open book with the spine and two opposite covers of the book being arranged adjacent to the elongated support bar," as recited in claim 36. Rather, Jones provides absolutely
10 no teaching that the book marker is capable of "supporting" anything. Jones does not teach that the telescoped sections 14,16 of the back member 12 are strong and stiff. Jones does not teach that the telescoped sections 14,16 of the back member 12 are not made of paper or thin plastic or otherwise so flimsy and flexible as to be incapable of supporting the book in an open position. Thus, the book markers is only "inherently" capable of being supported by the book along its spine. The book marker does not need to be even self-supporting to be satisfactory for interposing
15 the several book page separating cords 30 between the book pages for marking passages, which is its intended function. Column 1, lines 1-6.

For at least the above reasons, the invention as recited in claim 36 is clearly not anticipated by the book marker of Jones and is clearly allowable thereover.

Additionally, the back member 12 of the Jones's book marker is not "structured for
20 supporting an open book thereon across to a spine of the open book with the spine and two opposite covers of the book being arranged adjacent to the elongated support bar, the support bar being formed with two opposing edges spaced apart across a length of the support bar that is greater than a width thereof;" as recited in claim 36. Rather, the back member 12 corresponds in "length" to a "height" of a book. Column 1, lines 39-49; see, also, Figure 1. Thus, the back
25 member 12 cannot support an "open" book across to a spine of the open book with the spine and two opposite covers of the book being arranged adjacent to the elongated support bar," as recited in claim 36; because the back member 12 is not "formed with two opposing edges spaced apart across a length of the support bar that is greater than a width thereof" as further recited in claim 36.

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Furthermore, turning the back member 12 of Jones's book marker "across to a spine of the open book with the spine and two opposite covers of the book being arranged adjacent to the elongated support bar," as recited in claim 36, clearly would render the book marker unsatisfactory for its intended function of interposing the several book page separating cords 30 between the book pages for marking passages. Column 1, lines 1-6. Also, see Figure 4 that clearly shows the book marker of Jones having the back member 12 laid along the spine of the book, which is required for its intended purpose.

For this additional reason, the book marker of Jones is not "inherently" capable of supporting the book as recited in claim 36.

10 For at least the above additional reasons, the invention as recited in claim 36 is clearly not anticipated by the book marker of Jones and is clearly allowable thereover.

The book page separating cords 30 of Jones cannot anticipate the "resilient elastic retainer" recited in claim 36. The examiner's arguments based on dictionary definitions of "resilient" and "elastic" are utterly specious. If all "cords" are "resilient," then even iron is 15 "resilient" because it is capable of being hammered back into an original shape or position. If all "cords" are "elastic," then even iron is "elastic" because it is capable of being hammered back into an original shape. However, the examiner cannot be intending to make such arguments.

Therefore, at least because iron cannot be reasonably portrayed as "resilient" or "elastic," neither can the "cord" 30 of Jones. To be "resilient" the cord 30 would have to be "marked by the 20 ability to recover readily" or "capable of returning to an original shape or position, as after being compressed." Obviously, the cord 30 of Jones has neither "ability." Rather, the cord 30 cannot return itself to its original shape or position, but must be returned by some outside force. Therefore, the cord 30 is not "resilient."

Additionally, to be "elastic" the cord 30 would have to be "a flexible stretchable fabric 25 made with interwoven strands of rubber or an imitative synthetic fiber, or an object made of this fabric, or a rubber band. Obviously, Jones does not teach the "cord" 30 as being any of the above.

Alternatively, the "cord" 30 would have to be "easily resuming original shape after being stretched or expanded; flexible; or springy; rebounding." Obviously, the cord 30 of Jones cannot "return" to its original shape after being stretched or expanded. Rather, if stretched or expanded, 30 a "cord" as taught by Jones will just stay the altered stretched or expanded shape upon release,

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unless forced back into the original shape by outside forces. It is not "springy" or "rebounding" because it naturally retains its altered stretched or expanded shape upon release. We know this because the "cord" 30 is a "cord." It is not an "elastic band" because if it was an "elastic band," Jones would have taught it as being an "elastic band." But Jones did not teach the "cord" 30 as being an "elastic band." Rather, Jones taught the "cord" 30 as being exactly a "cord" and nothing else.

Since the "cord" 30 of Jones is not "resilient" and is not "elastic," what is it? A "cord" is "a slender length of flexible material usually made of twisted strands of fibers and used to bind, tie, connect, or support." See, e.g., "cord" at YAHOO!® Education (copy attached). Obviously, 10 nothing in this definition suggests that the "cord" is either "resilient" or "flexible." Thus, the "cord" of Jones does not teach any "resilient elastic retainer," as recited in claim 36.

For this additional reason, the book marker of Jones is not "inherently" capable of supporting the book as recited in claim 36.

For at least the above additional reasons, the invention as recited in claim 36 is clearly not anticipated by the book marker of Jones and is clearly allowable thereover. Reconsideration and allowance are respectfully requested.

Claims 10, 11, 14 and 18 are allowable at least as depending from allowable claim 36.

Claims 19-20 and 25 were rejected under 35 U.S.C § 102(b) as being unpatentable over reference 2002-127642 to Sato.

The present invention is clearly patentable over Sato, which teaches a page control implement having main parts A(1) and B(2) connect on a hinge (3), two elastic bands (4) and (6) are attached to opposite ends of a transparent band (5). A fixed board (7) is attached to an end of elastic band (6) with a stuck surface fastener (8) on the back of the other end of the fixed board 25 (7); and stuck surface fastener (8) is fastened to a prepared surface fastener (9) in the other end of main part B(2). See, e.g., Claim 1.

Claim 19 uses the limiting transitional phrase, "consisting of," which limits the elements to those set forth in the claim.

However, claim 19 was examined as if it used the "consisting essentially of" transitional phrase recited instead in claims 35 and 36. Therefore, these claims have been improperly examined as being equivalent to "comprising."

It is settled law that the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith."). But see *Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1331-32, 70 USPQ2d 1508, 1516 (Fed. Cir. 2004) (holding that a bone repair kit "consisting of" claimed chemicals was infringed by a bone repair kit including a spatula in addition to the claimed chemicals because the presence of the spatula was unrelated to the claimed invention). A claim which depends from a claim which "consists of" the recited elements or steps cannot add an element or step. When the phrase "consists of" appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986). See, also, MPEP §2111.03 Transitional Phrases.

Therefore, because claim 19 recites the limiting phrase "consisting of," and the element "a single resilient elastic retainer," the device is legally limited to "a single resilient elastic retainer." In contrast, the Sato device includes two elastic bands (4) and (6) separated by a transparent band (5). Clearly, two elastic bands is not "a single" resilient elastic retainer, as recited in closed claim 19. Furthermore, "a single resilient elastic retainer" is not a transparent band (5) connected between two separate elastic bands (4) and (6). Therefore, both the transparent band (5) and the second of the two elastic bands (4) and (6) are "ingredient not specified in the claim."

For at least this reason, claim 19 is clearly allowable over Sato when the proper "consisting of" standard of examination is applied, and reconsideration and allowance are respectfully requested.

Claim 25 is allowable at least as depending from allowable claim 19.

Claim 20 differs in scope from allowable claim 19. However, claim 20 also recites the limiting phrase "consisting of," Therefore, the above arguments and reasons for allowance directed to claim 19 are sufficiently applicable to claim 20 as to make repetition unnecessary. Thus, for

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each of the reasons above, claim 20 is believed to be allowable, and reconsideration and allowance are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over 6 US Patent 2,645,197 to Jones in view of US Patent 922,858 to Conley.

Claim 13 is allowable at least as depending from allowable claim 36.

Furthermore, claim 13 is not made obvious by Jones and Conley.

The examiner suggests that it would have been obvious to use the material of Conley with the support member of Jones. However, as discussed above, the Jones book marker of any material is significantly different from the invention recited in claim 36. As discussed at length above, the back member 12 of the Jones's book marker is not "structured for supporting an open book thereon across to a spine of the open book with the spine and two opposite covers of the book being arranged adjacent to the elongated support bar, the support bar being formed with two opposing edges spaced apart across a length of the support bar that is greater than a width thereof," as recited in claim 36.

As also discussed at length above, turning the back member 12 of Jones's book marker "across to a spine of the open book with the spine and two opposite covers of the book being arranged adjacent to the elongated support bar," as recited in claim 36, clearly would render the book marker unsatisfactory for its intended function of interposing the several book page separating cords 30 between the book pages for marking passages. Column 1, lines 1-6. Also, see Figure 4 that clearly shows the book marker of Jones having the back member 12 laid along the spine of the book, which is required for its intended purpose.

As further discussed at length above, the book page separating cords 30 of Jones cannot disclose or suggest the "resilient elastic retainer" recited in claim 36 at least because the cord 30 is not "resilient" and is not "flexible." Thus, the "cord" of Jones does not disclose or suggest any "resilient elastic retainer," as recited in claim 36.

Thus, merely using the material of Conley with the support member of Jones cannot possibly disclose or suggest the underlying invention recited in base claim 36.

For at least this reason, claim 13 is clearly allowable, and reconsideration and allowance are respectfully requested.

Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over 6 US Patent 2,645,197 to Jones in view of US Patent 6,453,589 to Schwartz.

Claim 15 is allowable at least as depending from allowable claim 36.

5 Furthermore, claim 15 is not made obvious by Jones and Conley.

As the examiner admits, and the applicant agrees, Schwartz teaches an “elastic string” ST1 that is a “fabric elastic coated elastic” although it can be a “pure rubber band.” Column 4, lines 41-43. The examiner suggests that it would have been obvious to use the fabric covered elastic material of Schwartz with the cord 30 of Jones.

10 It is well-settled law that a teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

15 As discussed at length above, the Jones book marker is only intended to lay the “page separating cords” 30. Column 2, lines 40-43. Thus, the non-resilient and non-elastic “page separating cords” 30 of Jones make the book marker 10 satisfactory for its intended function of facilitating the convenient and expedition opening of a book at several different passages. Column 1, lines 1-6. Therefore, Jones does not teach or suggest substituting an “elastic string” for the non-resilient and non-elastic “page separating cords” 30 at least because the “cords” are perfectly suited to accomplish their purpose of being interposed between the pages for marking the 20 different passages.

Schwartz only teaches a **file folder**. See, e.g., Abstract. Furthermore, Schwartz only teaches the elastic band ST1 for retaining a portion of the front cover hinged panel of the file folder in a folded back configuration with the front cover closed and retained behind the third corner portion of the elastic band member. See, e.g., Summary of the Invention at column 3, lines 28-38.
25 Additionally, Schwartz teaches the elastic band ST1 being “pulled up onto the front of the file folder” where it “does not interfere with the ability to fold the front panel back and positions the elastic behind the hinge panel portion when it is actually folded back or folded locked inward.” Column 3, lines 51-59. Thus, Schwartz does not teach substituting the elastic band ST1 for the cord in the book marker of Jones.

Furthermore, Schwartz can be read as teaching away from any combination with Jones. In contrast to Jones, Schwartz only uses the elastic band ST1 for actually retaining the file folder covers in place; and arranges the elastic band ST1 for not interfering with opening the hinged panel portion. Conversely, Jones teaches the cords 30 for being intentionally interposed between 5 the pages; and arranges the cords 30 adjacent to the spine of the book so that they cannot interfere with closing the book by holding back the covers, as the elastic band ST1 intentionally does.

Jones can also be read as teaching away from any combination with Schwartz. The above contrasts between Schwarz and Jones also exist in reverse.

10 Therefore, there is no teaching or suggestion to make the claimed combination in either Jones or Schwartz. In fact, both Jones or Schwartz can be read to teach away from the combination.

15 There being no such teaching or suggestion found in the references to make the claimed combination, the examiner must use impermissible hindsight based upon the applicant's disclosure to make the combination.

Thus, there is no teaching or suggestion to combine the elastic band ST1 of Schwarz with the cord 30 of Jones. For at least this reason, claim 15 is clearly allowable, and reconsideration and allowance are respectfully requested.

20 **Claims 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over 6 US Patent 922,858 to Conley in view of US Patent 4,555,128 to White.**

Claims 22-24 are allowable at least as depending from allowable claim 35.

25 The claims now being in form for allowance, reconsideration and allowance is respectfully requested.

If the Examiner has questions or wishes to discuss any aspect of the case, the Examiner is encouraged to contact the undersigned at the telephone number given below.

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